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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,016	12/03/2003	Robert M.H. Dunn	CA920030030US1	4460
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IBM CORP. (WSM) c/o WINSTEAD SECHREST & MINICK P.C. P.O. BOX 50784 DALLAS, TX 75201			EXAMINER ALMATRAHI, FARIS S	
			ART UNIT 3627	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,016	<b>Applicant(s)</b> DUNN ET AL.	
	<b>Examiner</b> FARIS ALMATRAHI	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/03/2003</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Application***

1. **Claims 1-28** are pending in this application.
2. **Claims 1-18 and 28** are withdrawn from consideration in this application due to restriction requirement.

### ***Claim Objections***

3. **Claims, drawings, and specifications** are objected to because of the following informalities: The term “centre” is viewed by the examiner to be a misspelling, British version, of the term “center”. Appropriate correction is required.

### ***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18 and 28, drawn to an order management system comprising computer executable mediums, classified in class 705, subclass 22.
  - II. Claims 19-27, drawn to a method of filling orders comprising generic or non-electrical computing, classified in class 705, subclass 500.

5. The inventions are distinct, each from the other because of the following reasons:

Invention I is related to Invention II as process and apparatus for its practice.

The inventions are distinct if it can be shown that *either*: (1) the process as claimed can be practiced by another, materially different apparatus, or by hand, *or* (2) the apparatus as claimed can be used to practice another, materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another, materially different apparatus, or by hand, such as by performing at least some of the recited method steps by hand/manually.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Joseph Bracken on January 9, 2008, a provisional election was made to prosecute Invention II, claims 19-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-18 and 28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 19-27** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A single claim which claims both a system and the method steps is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101. Claim 19 is directed to a method and overlaps disclosure of a system "the order management system comprising a set of fulfillment centre objects for representing the one or more fulfillment centres and the one or more electronic marketplaces, comprising a first subset of the fulfillment centre objects being defined for representing corresponding fulfillment centres, and a second subset of the fulfillment centre objects being defined for representing corresponding electronic marketplaces".

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 21-24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. **Claim 21** recites the limitation "representing inventory and/or fulfillment centre priority". The phrase "and/or" is viewed to be indefinite because it is unclear if applicant is referring to both inventory and fulfillment centre or either inventory or fulfillment centre. Similar comments apply to claims 22-23.

13. **Claim 24** recites the limitation "the step of an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects.". There is insufficient antecedent basis for the phrase "the pre-selection" in the claim. It is unclear as to what the applicant is referring to.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. **Claims 19-27** are rejected under 35 U.S.C. 102(e) as being anticipated by Hirth et al. (US Publication No. 2003/0171962 A1).

16. Regarding claim 19, Hirth discloses a method for filling orders for items using an order management system, the items being supplied from one or more fulfillment centers or from suppliers enrolled in one or more electronic marketplaces (Abstract, Paragraph [0049]), the order management system comprising a set of fulfillment centre objects for representing the one or more fulfillment centers and the one or more electronic marketplaces (Abstract, Paragraph [0038]), comprising a first subset of the fulfillment centre objects being defined for representing corresponding fulfillment centers, and a second subset of the fulfillment centre objects being defined for representing corresponding electronic marketplaces (Abstract, Paragraphs [0053] – [0054]), the method comprising the steps of associating one or more items in an order with one of the set of fulfillment centre objects using a release to fulfillment object (Abstract, Paragraphs [0038] – [0041]), sending fulfillment instructions relating to one or more items associated with one of the first subset of fulfillment centre objects to the corresponding fulfillment centre (Paragraphs [0041] – [0042], and sending ordering information relating to one or more items associated with one of the second subset of fulfillment centre objects to the corresponding electronic marketplace (Paragraphs [0041] – [0042]).

17. Regarding claim 20, Hirth discloses a method in which a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset comprise data representations for tracking orders in the electronic marketplace

corresponding to the selected fulfillment centre object (Paragraph [0043], Paragraph [0049], Paragraph [0076]).

18. Regarding claim 21, Hirth discloses a method in which each fulfillment centre objects comprises means for representing inventory and/or fulfillment center priority (Paragraph [0041]).

19. Regarding claim 22, Hirth discloses a method in which the means for representing inventory and/or fulfillment centre priority in the second subset of fulfillment centre objects represents a null inventory and/or a low fulfillment centre priority (Paragraph [0041], Paragraph [0083]).

20. Regarding claim 23, Hirth discloses a method further comprising the step of pre-selecting items for association with one of the set of fulfillment centre objects based on inventory and/or fulfillment centre priority (Paragraph [0041], Paragraph [0083] – [0085]).

21. Regarding claim 24, Hirth discloses a method in which the order management system comprises an administrator interface, and the method further comprises the step of an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects (Figure 5, Paragraph [0088]).

22. Regarding claim 25, Hirth discloses a method further comprising the step of grouping items and in which the step of sending ordering information further comprises maintaining the grouping of the items when information corresponding to the grouped



items is sent to the corresponding electronic marketplace (Paragraph [0010], Paragraphs [0053] – [0055]).

23. Regarding claim 26, Hirth discloses a method in which the step of grouping items comprises grouping the items corresponding to the order from which the items were received by the order management system (Paragraph [0054]).

24. Regarding claim 27, Hirth discloses a method in which the step of grouping items comprises grouping the items corresponding to an aggregation of items from a single order received by the order management system (Abstract, Paragraph [0010]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571) 270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627

Faris Almatrahi  
Examiner  
Art Unit 3627

FA